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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/341,543 02/17/00 RADIGON

E ATOCM-151

EXAMINER

IM22/0531

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SZEKELY, P

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

05/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/341,543

Applicant(s)

Radigan et al.

Examiner

Szekels

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2/16/01
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-23 is/are pending in the application.
- Of the above claim(s) 18-23 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1714

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I, claims 1-17, in Paper No. 12 is acknowledged. The traversal is on the ground(s) that the groups are related as combination/subcombination. This is not found persuasive because the groups are related as intermediate/final product, since the composition becomes an inseparable article. Therefore a showing of a two-way utility is not required. Furthermore, examination of the restricted claims would place extra burden on the examiner, since search of Group II is not required for the examination of Group I.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 22 and 23, (newly submitted), are directed to an article. Neither of these claims is directed to a composition, that is they are directed to a non-elected invention. Accordingly both of these claims are withdrawn by the examiner. Claims 18-23, not directed to the process of making or using the claimed composition, will not be rejoined.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

Art Unit: 1714

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention in the specification of a non- reactive HMPSA. This is a negative limitation, requiring explicit antecedent basis in the specification. The limitation in claims 11 and 15, that the MFI has to be at least 200 mg/10 min., cannot be found either. 200g/10 min. maybe?

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The word "derivative" renders these claims indefinite. CO₂ is a derivative of both rosin and terpene. It is derived by burning. In claim 17, both rosin and rosin derivatives are misspelled as --resin-- and --resin derivatives--, respectively. In claims 6, 16 and 17, the expression, "said tackifying agent", has no antecedent basis in the claims.

Art Unit: 1714

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1-5 and 8-15 are rejected under 35 U.S.C. 102(e) as being anticipated by ATO Findley S.A. WO 97/12007.

9. Findley discloses an alkyl ethylene-acrylate copolymer, tackifying resin and thinning agent, (plasticizer), in claim 1. The alkyl acrylate can be 2-ethylhexyl acrylate, (claim 3). The MFI is between 0.5 and 1000 g/10/min., (claim 4). The tackifier is 30-80% of the composition, the plasticizer concentration is up to 35% of the composition. See claim 6. Mixture of copolymers is discussed on page 6, lines 9-12. Applicants' claims are not novel.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1714

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over ATO Findley S.A. WO 97/12007.

13. The reference has been discussed already in paragraph #9. It shows tackifiers, which are the same as the tackifiers claimed by applicants, on page 6, lines 13-21 and page 7, lines 1-2. It is probable therefore, that the softening point ranges of these tackifiers is going to be similar to the ones in the instant application. Furthermore, since the criticality of said softening point ranges has not been elucidated in the specification, the examiner holds, that the choice of any tackifier, having any softening point, would have been obvious to one having ordinary skill in the art, at the time the invention was made.

Art Unit: 1714

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. This application contains claims 18-23 drawn to an invention non-elected with traverse in Paper No. 12. A complete reply to the final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on Tuesday through Friday from 7:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the

Art Unit: 1714

organization where this application or proceeding is assigned is (703) 305-3599 or (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'Peter Szekely', with a long horizontal flourish extending to the right.

Peter Szekely

Primary Examiner

Art Unit 1714